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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,795	12/02/2003	Thomas G. Cooper	017516-009610US	6144

7590 08/30/2005

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EXAMINER

NGUYEN, VI X

ART UNIT PAPER NUMBER

3731

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,795

Applicant(s)

COOPER ET AL.

Examiner

Victor X. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 38-42 is/are pending in the application.
- 4a) Of the above claim(s) 38-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04-05-2005 1/26/05; 5/4/05

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Morley et al (6,676,684).

Morley et al disclose in figures 6-8, abstract, a device for providing a minimally invasive surgical tool having the limitations as recited in claims 1-3, including: an elongate shaft (14.1,14.3), an end effector (58), a wrist member (52) has a flexible tube which is connected to the working end of the elongate shaft and a distal portion connected to the end effector and a spring (70, see col. 9, lines 40-52), where the spring is disposed inside the cavity of the tube, and where a plurality of cables (C1,C2) can dispose inside the inner spring and capable of connecting to the end effector which are capable of bending the wrist member in pitch (fig. 7) rotation and yaw (fig. 6) rotation.

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Madhani et al (6,786,896).

Madhani et al disclose in figures 1-3, a device for providing a minimally invasive surgical tool having the limitations as recited in claims 1-3, including: an elongate shaft (312), an

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end effector (318), a wrist member (316) has a flexible tube and a spring (see col.24, lines 10-35), where the spring is disposed inside the cavity of the tube, and where a plurality of cables (see col. 16, lines 59-67 and col. 17, lines 1-24) connected to the end effector which are capable of bending the wrist member in pitch (fig.2) rotation and yaw (at joint 6, see col. 15, lines 49-67) rotation.

Response to Arguments

2. Applicant's arguments filed 6/3/2005 have been considered but they are not persuasive. In response to applicant's argument that Morley reference does not disclose a wrist member having a flexible tube and an inner spring: As claim 1 is currently written, it can be interpreted broadly that the Morley reference at least discloses in figs. 6 and 7, a wrist member (52) having a flexible tube and an inner spring (70). There is some degree of flexibility in all materials. Therefore, the wrist member 52 can have a flexible tube that is bendable in order to change the orientation of the end effector (58) as a whole, relative to the wrist member. Accordingly, the above noted reference is still considered to read on the claimed limitations of the claims noted.

Newly submitted claims 38-42 are directed to an invention that is dependent from non-elected invention for the following reasons: originally presented claims 1-3 were related to Species 1, for figs. 1-3 (which was elected in 8/30/2004). While newly submitted claims 38-42 directed to Species 6 of figs. 8-9 and Species 14 of figure 20, which is distinct from the originally claimed species. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively by original presentation for prosecution on the merits. Therefore, **claims 38-42 are withdrawn from consideration** as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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Conclusion

3. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen
Examiner
Art Unit 3731

Vn *VW*
8/22/2005

Julian W. Woo

**JULIAN W. WOO
PRIMARY EXAMINER**